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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/712,990

11/17/2003

Jose A. Ramirez

12067-0006

9395

22902

7590

07/27/2006

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EXAMINER

STITZEL, DAVID PAUL

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 07/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/712,990	RAMIREZ ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	David P. Stitzel, Esq.	1616	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 34-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-33 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## OFFICIAL ACTION

### *Acknowledgment of Receipt*

Receipt of the Applicants' Election, with traverse, of Invention I, encompassing claims 1-33, which was filed on April 24, 2006, in response to the Official Action mailed on December 27, 2006, is acknowledged.

Applicant's traversal of the aforementioned restriction requirement on the grounds that said restriction requirement is improper and that a prior art search and examination of the claims of the inventions as set forth in Inventions I through IV would not impose a serious search burden, is duly noted. However, a proper prima facie case of undue search burden associated with a prior art search and examination of the claims of the separate, distinct and independent inventions of Groups I through IV has previously been established in the aforementioned Official Action. As a result, the restriction requirement is deemed proper and therefore made FINAL.

### *Status of Claims*

Claims 34-37 are withdrawn from further consideration as being directed to a non-elected invention. As a result, claims 1-33 are currently pending.

### *Supplemental Restriction/Election*

Upon further consideration, Applicants are also required under 35 U.S.C. § 121 to elect a single disclosed patentably distinct species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held allowable:

1. Claims 1 and 4 are generic to a plurality of disclosed patentably distinct species of ***aromatic alcohol*** (e.g., benzyl alcohol). The disclosed species are patentably distinct, each from the other, because they possess different molecular structures, as well as different chemical and physical properties. Therefore, restriction for examination purposes as indicated is proper.

Even though this requirement is traversed, Applicants are required under 35 U.S.C. § 121 to elect a single disclosed patentably distinct species of aromatic alcohol (e.g., benzyl alcohol) for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held allowable. Currently, claims 1 and 4 are generic. Applicant should also include a chemical structure of the elected compound, if a chemical structure of said compound is not already contained within the instant specification.

2. Claims 1 and 5 are generic to a plurality of disclosed patentably distinct species of *cyclic carboxylic acid* (e.g., benzoic acid). The disclosed species are patentably distinct, each from the other, because they possess different molecular structures, as well as different chemical and physical properties. Therefore, restriction for examination purposes as indicated is proper.

Even though this requirement is traversed, Applicants are required under 35 U.S.C. § 121 to elect a single disclosed patentably distinct species of cyclic carboxylic acid (e.g., benzoic acid) for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held allowable. Currently, claims 1 and 5 are generic. Applicant should also include a chemical structure of the elected compound, if a chemical structure of said compound is not already contained within the instant specification.

3. Claims 6-10 are generic to a plurality of disclosed patentably distinct species of *nonionic surfactant* (e.g., propylene oxide block copolymer). The disclosed species are patentably distinct, each from the other, because they possess different molecular structures, as well as different chemical and physical properties. Therefore, restriction for examination purposes as indicated is proper.

Even though this requirement is traversed, Applicants are required under 35 U.S.C. § 121 to elect a single disclosed patentably distinct species of nonionic surfactant (e.g., propylene oxide block

copolymer) for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held allowable. Currently, claims 6-10 are generic. Applicant should also include a chemical structure of the elected compound, if a chemical structure of said compound is not already contained within the instant specification.

4. Claims 11-13 are generic to a plurality of disclosed patentably distinct species of *cationic sequestering agent* (e.g., 1-hydroxyethylidene-1,1-diphosphonic acid). The disclosed species are patentably distinct, each from the other, because they possess different molecular structures, as well as different chemical and physical properties. Therefore, restriction for examination purposes as indicated is proper.

Even though this requirement is traversed, Applicants are required under 35 U.S.C. § 121 to elect a single disclosed patentably distinct species of cationic sequestering agent (e.g., 1-hydroxyethylidene-1,1-diphosphonic acid) for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held allowable. Currently, claims 11-13 are generic. Applicant should also include a chemical structure of the elected compound, if a chemical structure of said compound is not already contained within the instant specification.

5. Claims 14-18 are generic to a plurality of disclosed patentably distinct species of *anionic surfactant* (e.g., dodecyl benzene sulfonic acid). The disclosed species are patentably distinct, each from the other, because they possess different molecular structures, as well as different chemical and physical properties. Therefore, restriction for examination purposes as indicated is proper.

Even though this requirement is traversed, Applicants are required under 35 U.S.C. § 121 to elect a single disclosed patentably distinct species of anionic surfactant (e.g., dodecyl benzene sulfonic acid) for prosecution on the merits to which the claims shall be restricted if no generic claim is finally

held allowable. Currently, claims 14-18 are generic. Applicant should also include a chemical structure of the elected compound, if a chemical structure of said compound is not already contained within the instant specification.

6. Claim 22 is generic to a plurality of disclosed patentably distinct species of **buffer** (e.g., phosphoric acid). The disclosed species are patentably distinct, each from the other, because they possess different molecular structures, as well as different chemical and physical properties. Therefore, restriction for examination purposes as indicated is proper.

Even though this requirement is traversed, Applicants are required under 35 U.S.C. § 121 to elect a single disclosed patentably distinct species of buffer (e.g., phosphoric acid) for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held allowable. Currently, claim 22 is generic. Applicant should also include a chemical structure of the elected compound, if a chemical structure of said compound is not already contained within the instant specification.

7. Claims 23-26 are generic to a plurality of disclosed patentably distinct species of **corrosion inhibitor** (e.g., 1,2,3-benzotriazole). The disclosed species are patentably distinct, each from the other, because they possess different molecular structures, as well as different chemical and physical properties. Therefore, restriction for examination purposes as indicated is proper.

Even though this requirement is traversed, Applicants are required under 35 U.S.C. § 121 to elect a single disclosed patentably distinct species of corrosion inhibitor (e.g., 1,2,3-benzotriazole) for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held allowable. Currently, claims 23-26 are generic. Applicant should also include a chemical structure of

the elected compound, if a chemical structure of said compound is not already contained within the instant specification.

8. Claims 28 and 29 are generic to a plurality of disclosed patentably distinct species of *hydrotrope* (e.g., sodium xylene sulfonate). The disclosed species are patentably distinct, each from the other, because they possess different molecular structures, as well as different chemical and physical properties. Therefore, restriction for examination purposes as indicated is proper.

Even though this requirement is traversed, Applicants are required under 35 U.S.C. § 121 to elect a single disclosed patentably distinct species of hydrotrope (e.g., sodium xylene sulfonate) for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held allowable. Currently, claims 28 and 29 are generic. Applicant should also include a chemical structure of the elected compound, if a chemical structure of said compound is not already contained within the instant specification.

9. Claims 30 and 31 are generic to a plurality of disclosed patentably distinct species of *solvent* (e.g., glycol). The disclosed species are patentably distinct, each from the other, because they possess different molecular structures, as well as different chemical and physical properties. Therefore, restriction for examination purposes as indicated is proper.

Even though this requirement is traversed, Applicants are required under 35 U.S.C. § 121 to elect a single disclosed patentably distinct species of solvent (e.g., glycol) for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held allowable. Currently, claims 30 and 31 are generic. Applicant should also include a chemical structure of the elected compound, if a chemical structure of said compound is not already contained within the instant specification.

### ***Conclusion to Restriction Requirement***

Applicants are advised that a fully responsive reply to this requirement must include an explicit identification of a single disclosed patentably distinct species of: ***aromatic alcohol*** (e.g., benzyl alcohol); ***cyclic carboxylic acid*** (e.g., benzoic acid); ***nonionic surfactant*** (e.g., propylene oxide block copolymer); ***cationic sequestering agent*** (e.g., 1-hydroxyethylidene-1,1-diphosphonic acid); ***anionic surfactant*** (e.g., dodecyl benzene sulfonic acid); ***buffer*** (e.g., phosphoric acid); ***corrosion inhibitor*** (e.g., 1,2,3-benzotriazole); ***hydrotrope*** (e.g., sodium xylene sulfonate); and ***solvent*** (e.g., glycol), that is elected consonant with this requirement, and a listing of all claims, including any claims subsequently added thereto, which are readable upon the elected species. An argument that a claim is allowable or that claims are not generic is considered nonresponsive unless accompanied by an explicit election of a specific species and subspecies. See 37 C.F.R. § 1.143.

Should Applicant traverse on the ground that the species are not patentably distinct, Applicant should submit evidence or identify such evidence now of record showing the species and subspecies to be obvious variants over one another or clearly admit on the record that this is the case. In either instance, if the Examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103(a) of the other inventions.

If claims are added after the election, Applicant must explicitly indicate which claims are readable upon the elected species. See MPEP § 809.02(a). Amendments submitted after final rejection are governed by 37 CFR 1.116, whereas amendments submitted after allowance are governed by 37 CFR 1.312.

Due to the complex nature of the instant election of species requirement, a written restriction requirement was necessitated. See MPEP § 812.01.



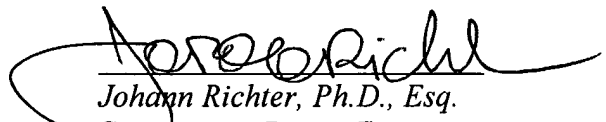
***Contact Information***

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to David P. Stitzel, M.S., Esq., whose telephone number is 571-272-8508. The Examiner can normally be reached on Monday-Friday, from 7:30AM-6:00PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Johann Richter, Ph.D., Esq., can be reached at 571-272-0646. The central fax number for the USPTO is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published patent applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished patent applications is only available through Private PAIR. For more information about the PAIR system, please see <http://pair-direct.uspto.gov>. Should you have questions about acquiring access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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